



**Sterne Kessler  
Goldstein Fox**

ATTORNEYS AT LAW



**RECEIVED**

AUG 08 2002

TECH CENTER 1600/2900

August 7, 2002

Robert Greene Sterne  
Edward J. Kessler  
Jorge A. Goldstein  
David K.S. Cornwell  
Robert W. Esmond  
Tracy-Gene G. Durkin  
Michele A. Cimbalà  
Michael B. Ray  
Robert E. Sokohl  
Eric K. Steffe  
Michael Q. Lee  
Steven R. Ludwig  
John M. Covert  
Linda E. Alcorn  
Robert C. Millonig  
Lawrence B. Bugalsky  
Donald J. Featherstone  
Michael V. Messinger

Judith U. Kim  
Timothy J. Shea, Jr.  
Patrick E. Garrett  
Jeffery T. Hevey\*  
Heidi L. Kraus  
Crystal D. Sayles  
Edward W. Yee  
Albert L. Ferro\*  
Donald R. Banowitz  
Peter A. Jackman  
Molly A. McCall  
Teresa U. Medler  
Jeffrey S. Weaver  
Kendrick P. Patterson  
Vincent L. Capuano  
Albert J. Fasulo II\*  
Eldora Ellison Floyd  
W. Russell Swindell

Thomas C. Fiala  
Brian J. Del Buono  
Virgil Lee Beaston\*  
Reginald D. Lucas\*  
Kimberly N. Reddick  
Theodore A. Wood  
Elizabeth J. Haanes  
Bruce E. Chalker  
Joseph S. Ostroff  
Frank R. Cottingham\*  
Christine M. Lhulier  
Rae Lynn Prengaman\*  
Jane Shershenovich\*  
Lawrence J. Carroll\*  
George S. Bardmesser

**Registered Patent Agents\***  
Karen R. Markowicz  
Andrea J. Kamage  
Nancy J. Leith  
Joseph M. Conrad III  
Ann E. Summerfield  
Helene C. Carlson  
Gaby L. Longworth  
Matthew J. Dowd  
Aaron L. Schwartz  
Angelique G. Uy  
Boris A. Matvenko  
Mary B. Tung  
Katrina Y. Pei  
Bryan L. Skelton  
Jason D. Eisenberg  
John J. Figueroa

**Senior Counsel**  
Samuel L. Fox  
Kenneth C. Bass III  
Lisa A. Dunner

\*Admitted only in Maryland  
\*Admitted only in Virginia  
\*Admitted only in Texas  
\*Practice Limited to  
Federal Agencies

**WRITER'S DIRECT NUMBER:**

(202) 371-2560

**INTERNET ADDRESS:**

RESMOND@SKGF.COM

Commissioner for Patents  
Washington, D.C. 20231

**Art Unit 1623**

Re: U.S. Utility Patent Application  
Appl. No. 10/046,667; Filed: January 16, 2002  
For: **Reagent for the Isolation of RNA**  
Inventors: SIMMS, Domenica  
Our Ref: 0942.5220001/RWE/CJW

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement;
2. Form PTO-1449 (citing 12 documents - 4 pages);
3. One copy of each of the 12 cited documents: **AL1, AM1, AR1, AS1, AT1, AR2, AS2, AT2, AR3, AS3, AT3 and AR4;** and
4. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents

August 7, 2002

Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond

Attorney for Applicants

Registration No. 32,893

RWE/CJW/rjv

Enclosures

SKGF\_DC1:42035.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of:

Simms, D.

Appl. No. 10/046,667

Filed: January 16, 2002

For: **Reagent for the Isolation of RNA**

Confirmation No. 3021

Art Unit: 1623

Examiner: *To Be Assigned*

Atty. Docket: 0942.5220001/RWE/CJW

**Information Disclosure Statement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of the documents are attached.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

The Examiner is referred to the following list of related, co-pending patent applications:

U.S. Patent Application No. 09/478,456, filed January 6, 2000, inventor Blakesley, R.W., is listed on the accompanying PTO-1449 forms as document **AR3**.

U.S. Patent Application No. 09/498,897, filed February 4, 2000, inventor Jesse, J., *et al.*, is listed on the accompanying PTO-1449 forms as document **AS3**.

U.S. Patent Application No. 10/073,260, filed February 13, 2002, inventor Simms, D., *et al.*, is listed on the accompanying PTO-1449 forms as document **AT3**.

**RECEIVED**  
AUG 08 2002  
TECH CENTER 1600/2900

U.S. Patent Application No. 09/585,580, filed June 2, 2000, inventor Lin, J.-J., is listed on the accompanying PTO-1449 forms as document AR4.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

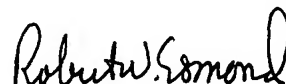
This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond  
Attorney for Applicant  
Registration No. 32,893

Date: Aug 7, 2002

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600

AUG 6 7 2002

FORM PTO-1449

## INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.  
0942.5220001APPLICATION NO.  
10/046,667APPLICANT  
Simms, D.FILING DATE  
January 16, 2002GROUP  
1623

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

**RECEIVED**  
AUG 18 2002  
TECH CENTER 1600/2900

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AL1	WO 96/34949 A1	11/07/1996	WIPO			Yes No
	AM1	WO 98/45311 A1	10/15/1998	WIPO			Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>1</u>	Bahloul, M. and Burkard, G., "An Improved Method for the Isolation of Total RNA from Spruce Tissues," <i>Plant Mol. Biol. Reporter</i> 11:212-215, Mary Ann Liebert, Inc (1993)
AS	<u>1</u>	Chang, S., et al., "A Simple and Efficient Method for Isolating RNA from Pine Trees," <i>Plant Mol. Biol. Reporter</i> 11:113-116, Mary Ann Liebert, Inc (1993)
AT	<u>1</u>	Dong, J. G., et al., "Cloning of a cDNA encoding 1-aminocyclopropane-1-carboxylate synthase and expression of its mRNA in ripening apple fruit," <i>Planta</i> 185:38-45, Springer-Verlag (1991).

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



FORM PTO-1449

INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.  
0942.5220001APPLICATION NO.  
10/046,667APPLICANT  
Simms, D.FILING DATE  
January 16, 2002GROUP  
1623**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

**RECEIVED**  
AUG 08 2002  
TECH CENTER 1600/29**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

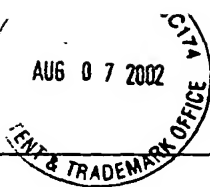
**OTHER (Including Author, Title, Date, Pertinent Pages, etc.)**

	AR	2	Graham, G.C., "A Method of Extraction of Total RNA from <i>Pinus radiata</i> and Other Conifers," <i>Plant Mol. Biol. Reporter</i> 11:32-37, Mary Ann Liebert, Inc (1993)
	AS	2	Schneiderbauer, A., et al., "Isolation of Functional RNA from Plant Tissues Rich in Phenolic Compounds," <i>Anal. Biochem.</i> 197:91-95, Academic Press, Inc. (1991).
	AT	2	International Search Report for International Patent Application No. PCT/US02/01017, mailed May 29, 2002.

EXAMINER	DATE CONSIDERED
----------	-----------------

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

AUG 07 2002



Page 3 of 4

FORM PTO-1449

## INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.  
0942.5220001APPLICATION NO.  
10/046,667APPLICANT  
Simms, D.FILING DATE  
January 16, 2002GROUP  
1623

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

**RECEIVED**  
AUG 08 2002  
TECH CENTER 1600/2900

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

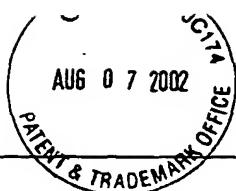
## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	3	Pending Non-Provisional U.S. Patent Application No. 09/478,456, Blakesley, R.W., filed January 6, 2000.
	AS	3	Pending Non-Provisional U.S. Patent Application No. 09/498,897, Jesse, J., et al., filed February 4, 2000.
	AT	3	Pending Non-Provisional U.S. Patent Application No. 10/073,260, Simms, D., et al., filed February 13, 2002.

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



FORM PTO-1449

INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.  
0942.5220001APPLICATION NO.  
10/046,667APPLICANT  
Simms, D.FILING DATE  
January 16, 2002GROUP  
1623

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

RECEIVED  
AUG 08 2002  
TECH CENTER 1600/2900

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>4</u>	Pending Non-Provisional U.S. Patent Application No. 09/585,580, Lin, J.-J., filed June 2, 2000.
	AS		
	AT		

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.